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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,165	11/24/2000	Shiro Morotomi	09812.0489-00000	3887
22852	7590	12/09/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			NGUYEN, HUY THANH	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,165

Applicant(s)

MOROTOMI ET AL.

Examiner

HUY T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Applicant's argument for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

The claims have been examined based on the new found references.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Yanagawa et al (6,745,252).

Regarding claims 1, Yanagawa discloses a recording and/or reproduction apparatus (VTR) (Figs. 4,5,16) for recording and/or reproducing data onto and/or from a storage medium, comprising:

recording and/or reproduction means for recording and/or reproducing data onto and/or from the storage medium (column 11, line 56 t column 12, line 35) ;

communication means (4,20) for communicating with an external apparatus (media controller) (column 2, lines 20-40, column 6, lines 36-55) ;

storage means for storing operation screen information corresponding to said recording and/or reproduction means (column 37 lines 30-68,m Fig.5).

producing means for producing an operation screen (columns 31, lines 1-45, Fig. 16);

transmission control means for controlling said communication means to transmit the operation screen information to the external apparatus (column 49, lines 40 to column 50, line 37); and

control means operable when said communication means receives operation information to the operation screen information displayed on the external apparatus for controlling said recording and/or reproduction means in accordance with the operation information (columns 31, lines 1-45, Fig. 16).

Method claim 26 corresponds to apparatus claim 1. Therefore, method claim 26 is rejected by the same reason as applied t apparatus claim 1.

Regarding claim 2, Yanagawa teaches the recording and/or reproduction apparatus according to claim 1, wherein said communication means is capable of communicating with the external apparatus through a network using a predetermined communicating with the external apparatus through a network using a predetermined communication protocol (column 6, lines 3-14).

Regarding claim 3, Yanagawa teaches the recording and/or reproduction apparatus according to claim 2, wherein said communication means is capable of communicating with the external apparatus through the network using the internal protocol (column 8, lines 15-22).

Regarding claim 4, Yanagawa teaches the recording and/or reproduction apparatus according to claim 3, wherein said communication means is capable of communicating with a personal computer through the network using the internet protocol (column 6, lines 20-30).

Regarding claim 5, Yanagawa teaches the recording and/or reproduction apparatus according to claim 1, wherein said storage means stores graphical user interface information to be used to remotely control said recording and/or reproduction means from the external apparatus (Figs. 5, 16).

Regarding claim 6, Yanagawa teaches the recording and/or reproduction apparatus according to claim 5, wherein said storage means stores the graphical user interface information at least of a reproduction instruction button, a recording instruction button and a reproduction stop button (Fig. 16).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al in view of Humpleman (6,288,716).

Regarding claim 7, Yanagawa fails to teach that the graphic interface is described in html format. Humpleman teaches a system for controlling devices using graphic user interface described in a HTML format (column 6 lines 10-45, column 8, lines 9-42). It would have been obvious to one of ordinary skill in the art to modify Yanagawa with Humpleman by using a format means as taught by Humpleman with the apparatus of Yanagawa for described the graphic user interface in a HTML format thereby enhancing the function of the graphic user interface when the external apparatus is a computer used for controlling the recording/ reproducing apparatus.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al in view of Takahashi et al (5,887,193).

Regarding claims 8 and 9, Yanagawa fails to teach an image pickup means for receiving image and sound data from an image pickup means and a microphone.

Takahashi teaches a camera (2) having an image pickup means and a recording/reproducing apparatus (camera media device 2), used as an alternative image source, receiving image and sound data from an image pickup means and a microphone, recording the image and sound on a medium (column 7, lines 55-68).

It would have been obvious to one of ordinary skill in the art to modify Yanagawa with Takahashi by using the camera of Takahashi as an alternative image source for the apparatus of Yanagawa thereby enhancing the capacity of the apparatus of Yanagawa for receiving an additional image source

7. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al. in view of Takahashi et al. as applied to claims 9 above, further in view of Shigenobu (JP10075424A).

Regarding claims 10 and 11, Takahashi fails to teach that the recording and/or reproduction means compresses the image data in accordance with the MPEG system and compresses the sound data in accordance with the ATRAC system.

Shigenobu teaches a recording/reproducing apparatus using an image pickup means and a microphone for generating image and sound and a compressing means for compressing image in accordance with a MPEG system and sound in accordance with an ATRAC system. It would have been obvious to one of ordinary skill in the art to modify Takahashi with Shigenobu by using a compressing means as

taught by Shigenobu with the recording/ reproducing apparatus of Yanagawa for compressing the image in accordance with MPEG and sound in accordance with ATRAC systems .

It would have been obvious to one of ordinary skill in the art to modify Yanagawa with Shigenobu by using a recording/ reproducing apparatus of Shigenobu as an alternative to the recording/ reproducing means of Takahashi for recording the compressed the image and sound thereby reduce the size of the medium .

Regarding claim 12, Yanagawa further teaches display means for displaying image data reproduced from the storage medium by said recording and/or reproduction means (Fig. 16).

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al in view of Nonaka (EP 0955635A).

Regarding claim 13, Yanagawa fails to teach that wherein said recording and/or reproduction means records and/or reproduces data onto and/or from an optical disk on which first tracks formed from a wobbled track which is wobbled on the opposite side faces thereof and a non-wobbled track which is not wobbled on the opposite side faces thereof are formed from ones of lands and grooves and information is recorded on second tracks formed from the others of the lands and the grooves positioned between the wobbled track and the non-wobbled track.

Nonaka teaches a recording/ reproducing apparatus for recording information on the land positioned between wobbled track and non-wobbled tracks (Fig. 1) . It

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would have been obvious to one of ordinary skill in the art to modify Yanagawa with Nonaka by using a recording/ reproducing means as taught by Nonaka for recording the information between Wobbled track and non wobbled track order to efficiently use space on disk to record the information .

9. Claim 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al in view of Maeda et al (5,559,780) .

Yanagawa fails to teach updating the program stored in the medium . Maeda teaches a recording apparatus having control means for updating the program stored in the medium (column 7, lines 60 to column 8, line 50). It would have been obvious to one of ordinary skill in the art to modify Yanagawa with Maeda by using a control means as taught by Yanagawa with the apparatus of Yanagawa for updating the stored program thereby enhancing the apparatus of Takahashi .

10. Claims 16 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa in view of Kori et al (EP 0716545).

Regarding claim 16, Yanagawa discloses a recording and/or reproduction apparatus (VTR or DVD) (Figs. 4-5,16) for recording and/or reproducing data onto and/or from a storage medium, comprising:

recording and/or reproduction means (VTR camera or DVD) for recording and/or reproducing data onto and/or from the storage medium (column 11, lines 56 to column 12, line 35) ;

communication means for communicating with an external apparatus (media controller) (column 1, lines 20-40, column 1, lines 20-40, column 17 lines 35-50) ;

transmission control means for controlling said communication means to transmit the operation screen information and data to the external apparatus (Figs. 4-5 and 16);
and

control means operable when said communication means receives operation information to the operation screen information displayed on the external apparatus for controlling said recording and/or reproduction means in accordance with the operation information (column 31).

Yanagawa fails to teach means for discriminating a type of the external apparatus and means for changing a format of the read out databases in the discriminating result.

Kori teaches an apparatus having a control means for detecting a type of a display apparatus and means for converting the image stored in a medium to a format can be displayed by the display apparatus (column 5, lines 20-35).

It would have been obvious to one of ordinary skill in the art to modify Yanagawa with Kori by providing the apparatus of Yanagawa with control means as taught by Kori for detecting the type of the external apparatus and for changing the format of the data read from the apparatus thereby enhancing the function of the apparatus of Yanagawa to change the format of the data when needed .

Method claim 27 corresponds to apparatus claim 16. Therefore method claim 27 is rejected by the same reason as applied to apparatus claim 16.

11. Claims 20-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al in view of Kori et al as applied to claim 16 above, further in view of Takahashi et al .

Regarding claims 20-21, Yanagawa fails to teaches a image pick up means for receiving image and sound data from an image pickup means and a microphone.

Takahashi teaches a camera (2) having a image pickup means and a recording /reproducing apparatus (camera media device 2) ,used as an alternative image source, receiving image and sound data from an image pickup means and a microphone , recording the image and sound on a medium (column 7, lines 55-68).

It would have been obvious to one of ordinary skill in the art t modify Yanagawa with Takahashi by using the camera of Takahashi as an alternative image source for the apparatus of Yanagawa thereby enhancing the capacity of the apparatus of Yanagawa for receiving an additional image source.

Regarding claim 24, Yanagawa further teaches display means for displaying image data reproduced from the storage medium by said recording and/or reproduction means (Fig. 16).

12. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et a in view of Kori et al as applied to claim 16 above, further in view of Shigenobu (JP1007542A).

Regarding claims 22 and 23, Yanagawa fails to teaches that the recording and/or reproduction means compresses the image data in accordance with the MPEG system and compresses the sound data in accordance with the ATRAC system.

Shigenobu teaches an recording/ reproducing apparatus using an image pickup means and a microphone for generating image and sound and a compressing mean for compressing image in accordance with a MPEG system and sound accordance with an ATRAC system . It would have been obvious to one of ordinary skill in the art to modify Yanagawa with Shigenobu by using well known means for compressing the image in accordance with MPEG and sound in accordance with ATRAC systems as taught by Shigenobu with the apparatus of Yanagawa for compressing the image data and sound thereby reducing the size of the medium .

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al in view of Kori et al as applied to claim 16 above, further in view of Nonaka (EP0955635A1).

Regarding claim 25, Yanagawa fails to teaches that wherein said recording and/or reproduction means records and/or reproduces data onto and/or from an optical disk on which first tracks formed from a wobbled track which is wobbled on the opposite side faces thereof and a non-wobbled track which is not wobbled on the opposite side faces thereof are formed from ones of lands and grooves and information is recorded on second tracks formed from the others of the lands and the grooves positioned between the wobbled track and the non-wobbled track.

Nonaka (EP0955635A1) teaches a recording/ reproducing apparatus for recording information on the land positioned between wobbled track and non-wobbled tracks (Fig. 1). It would have been obvious to one of ordinary skill in the art to modify Yanagawa with Nonaka by using a recording/ reproducing means as taught by Nonaka for recording the information between Wobbled track and non wobbled track as an alternative to the recording method of Yanagawa.

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al in view of Kori et al and Kimura (JP 10-187380 A)

Regarding claim 17, Yanagawa as modified with Kori fails to specifically wherein said discrimination means extracts an identifier representative of a type of the external apparatus from the transmission request information and discriminates the type of the external apparatus based on the extracted identifier.

Kimura discloses an apparatus (computer) having a communicating means for communication means with an external apparatus (printer) and for receiving requested from the external apparatus and extracting the identifier of the external apparatus and setting processing model for the external apparatus.

It would have been obvious to one of ordinary skill in the art to modify Yanagawa as modified with Kori with Kimura by providing the external apparatus with a identifier and transferring the identifier together with the request to the recording apparatus thereby accurately changing the format of data from the storage medium corresponding to the external apparatus.

Regarding claim 19, Yanagawa as modified with Kori further teaches when said discrimination means discriminates that the external apparatus is another recording and/or reproduction apparatus of the same type as that of said recording and/or reproduction apparatus, said transmission control means controls said communication means to transmit image data read out from the storage medium to external apparatus (See Kori , column 12, lines 6-15).

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagawa et al in view of Kori et al and Kimura as applied to claim 17 above, further in view of Humpleman (6,288,716).

Regarding claim 18 , Yanagawa fails to teach that the graphic interface is described in html format . However, it is noted that using storage means for storing graphic use interface data described in html format for a computer is well known in the art .

Humpleman teaches a system for controlling devices using graphic user interface described in a HTML format for a computer (column 6 lines 10- 45, column 8, lines 9-42).

It would have bee obvious to o of ordinary skill in the art to modify Yanagawa as modified with Kori and Kimura with Humpleman by using a format means as taught by Humpleman with the apparatus of Yanagawa for described the graphic user interface in a HTML format when discriminating that the external apparatus is a

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computer thereby enhancing the function of apparatus of Yanagawa to properly transmit the data corresponding to the type of external apparatus .

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY T. NGUYEN
PRIMARY EXAMINER